REMARKS

I.   Prosecution History

Claims 1-13 were presented for examination by Applicant's filing of a nonprovisional application on January 16, 2004. Under the first non-final Office Action, dated October 4, 2007, claims 1-13 were rejected under 35 U.S.C. 102(e) as being anticipated by Murren et al. (US Pub No 2003/0110085). Applicant amended claims 1, 6, 12 and 13 and requested reconsideration of the application.

Claims 1-13 were then finally rejected in a final Office Action, dated April 29, 2008, under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (2002/0007374). Applicant canceled claims 7 and 8 and amended claims 6, 9, 10, 11 and 12 to place the application in condition for allowance.

Under the Office Action, dated July 24, 2008, claims 1-13 were rejected and the amendments to claims 6 and 12 were not entered. The Examiner maintained the rejection to claims 1-13 under 35 U.S.C. §103(a) as being upatentable over Murren in view of Marks. Applicant filed a Request for Continued Examination.

Under the Non-Final Office Action, dated December 3, 2008, the finality of the previous office action was withdrawn and amendments submitted by Applicant on August 28, 2008, were entered. Claims 1-13 were rejected as being unpatentable over Murren in view of Marks.

Under the Office Action, made final, dated June 5, 2009, claims 1-6 and 9-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks and instant invention background. On March 2, 2009, Applicant Requested for Continued Examination, along with amendments to the claims 1-6 & 9-15, cancellation of claims 7 & 8, and added new claims 16 and 17.

Under the Non-Final Office Action, dated October 28, 2009, the finality of the previous office action was withdrawn and amendments submitted by Applicant on October 1, 2009, were entered. Claims 2-6 & 9-15 were cancelled and previously rejected claim 1 and new claims 16 & 17 were rejected as being unpatentable over Murren in view of Marks and instant invention background.

Claims 1 and 16 were amended to further limit the claimed invention by adding the limitation "wherein communication is all accomplished via multicast to subscribers by publisher enterprise equipment." The applicant drew the Examiners attention to paragraph [0002] which states that the Marks et al. invention "relates to a method and apparatus for supporting a multicast response to a unicast request to a document." The Applicant argued that by adding the phrasing "wherein communications is all accomplished via multicast to subscribers" that the prior art was required to possess multicasting throughout the communication schema in order to disclose the claimed invention.

Under the Office Action, made final, dated April 1, 2010, claims 1, 16, and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks and instant invention background. The Applicant filed a response to the Office Action on May 28, 2010.

Under the Advisory Action dated June 7, 2010, claims 1 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks and instant invention background. The Applicant filed amendments to the pending claims, a response, and a Request for Continued Examination on July 12, 2010.

Under the Non-Final Office Action, dated August 17, 2010, claims 1 and 16 were rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement, and 35 USC §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the Applicant regards as the invention. Claims 1 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks and instant invention background. The Applicant filed amendments to the claims and requested reconsideration in a response filed August 26, 2010.

Under the Final Office Action dated November 5, 2010, claims 1 and 16 stand rejected under 35 U.S.C §103(a) as being unpatentable over Murren '085 (US 2003/0110085) in view of Marks (US 2002/0007374). The Applicant, through the undersigned attorney of record, submitted proposed claims amendments and conducted a telephonic Examiner Interview on January 4, 2011 to discuss further limitations on the dynamic consolidation feature and structural differences between the claims and the prior art. The examiner stated that the proposed claims

continue to read on the prior art. The Applicant further amends the claims and respectfully requests reconsideration in this response.

II. Response to Arguments

Applicant's arguments with respect to claims 1, 16 and 17 have been considered but are moot in view of the new ground(s) of rejections. The Amendment to the claims necessitated the new grounds of rejection. However, the same references applied in the last Office Action are being applied below. The additional claim limitations added in the recent amendment are disclosed in the background of the invention. For example, as disclosed in the Applicant's specification, the print server facilitates multi-site load balancing while gauging the shipping and labor costs of each site in order to decide which site to master the print job. The original reference of Murren '085 discloses synchronizing data that represents hard copy flyers with a plurality of sites or network locations that represent the individuals that are interested in that information and provide the aspect of printing out this information. in addition, the updating of the respective sites or addresses interested in the information are done in an instantaneous manner since modern technology allows for information to be communicated to different entities in a quick manner through networking equipment.

III. Claim Rejections – 35 U.S.C. §103

Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

> "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (KSR Int'l v. Teleflex Inc.) states:

> "The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each

element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a reason that would have prompted a person to combine the elements and to make that analysis explicit. MPEP §2143 sets out the further basic criteria to establish a prima facie case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a prima facie showing of obviousness by the examiner (assuming there are no objections or other grounds for rejection) and of a prima facie showing by the examiner of a reason to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

Murren in view of Marks

Claims 1 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Murren '085 (US 2003/0110085) (hereafter known as "Murren") in view of Marks '374 (US 2002/0007374) (herein known as "Marks") and the background of the invention.

Regarding claim 1, the Examiner argues that Murren '085 discloses maintaining synchronization of information published to multiple subscribers, comprising:

publishing document library subject availability via multicast communication over a data network (citing the system of Murren '085, the tracking component (citing 106) publishes the availability of information within a subscribers criteria via a publishing component (citing 110). The Examiner argues that this is not only

given to a certain user, but to multiple users requesting the information. When updates occur to information within the user's criteria, multiple users' are notified by the publishing of the information to the users. The Examiner argues that publishing is interpreted as the dissemination of information to the public. The Examiner further argues that because the updates and the requesting of information within a user's criteria occurs over a network that notifies multiple user's at the same time, the system is considered to perform multicast communication, which is when multiple clients receive the same information from one server; citing fig. 1; paragraphs [0006]-[0025]) wherein said subject availability is predefined (citing in the system of Murren, the different keywords or items available online have a predetermined length of time that the items are to be subscribed to by a subscriber. Also, the actual information that is used to identify the item is predetermined; citing [0016]-[0025]);

receiving subscriptions for document library subjects via point-to-point data communication over the data network from remote subscribers at individual sites (citing the subscribers (citing 104) in the overall system support the World Wide Web and web pages. The Examiner argues that the subscribers can be considered a site since they receive information using the Internet and the system automatically sends information to the designated user using the web and web pages. The subscriber is able to subscribe to the system (citing 102) to receive different types of information from the publication and tracking systems. The Examiner then argues that the information received on the network used in the overall system to the subscribers at their respective locations on the network. The Examiner argues that information received is information regarding the subject matter that fits inside the subscribers desire criteria. The Examiner further argues that information relating to the subscribers criteria and information related to other criteria, or subjects, are stored on the system (citing 102); citing fig. 1; paragraphs [0006]-[0025]);

wherein said subscriptions comprise a configuration file that functions as a lookup table for subjects subscribed to by said subscribers (citing in a lookup table, the Examiner argues a value that is input yields a value that is output. Within the Murren reference, the user inputs in a criteria, whether that criteria involves

multiple subjects or one subject, and with the input of this criteria, the system maps this criteria to items that correspond with this criteria. In addition, the Examiner argues, the system maps the user to the information that is requested through the listed criteria. Therefore, the Examiner argues with the user being associated with the subjects requested and the subjects being associated with the input criteria, the above feature is performed; citing fig.6 [0020]-[0025] and [0048]-[0053]);

maintaining a records of subscriber data, subject data and publication-subscription logs utilizing a publish-subscribe middleware wherein said publish-subscribe middleware enables at least one server and at least one database to operate together for management of said records (citing the server (citing 102) is used with the tracking component (citing 106), which serves as a database, and these components maintain records of a subscriber (citing 606) and a publication-subscriber log of multiple subscribers (citing 608). The Examiner argues that data range is considered the publication–subscriber log because the information lists the time a subscriber subscribes to a publication on the network. The Examiner then argues that item identifier is considered as subject data since this information identifies an item that is subscribed to. Also, in figure 5, the Examiner argues that the input criteria entered by the subscriber can be stored in a dedicated area of the publishing component (citing 110), which is accessed by the server device (citing 102). This information can be considered as subject data. Since the server (citing 102) operates together with the information tracking component (citing 106), which contains a database, the Examiner argues that storing the above types of information together, the system can be considered to have publish-subscribe middleware; citing figs. 1-6, paragraphs [0047]-[0056]);

printing said document at said individual sites (citing in the system, the individual subscribers are able to make hard copy flyers of the information received from the network. The Examiner argues that each subscriber represents a site in which the document is received; citing [0023].

However, Murren '085 fails to teach via multicast communication over a data network and wherein communication is all accomplished via multicast to subscribers by publisher enterprise equipment.

However, the Examiner argues that this is well known in the art as evidence by Marks '374. Mark '374 discloses via multicast communication over a data network (citing it would have been obvious to one of ordinary skill in the art to combine the references of Murren and Marks since both involve the transmission of documents or other information to individuals subscribing to the information on a network (citing same field of endeavor). In the system, the network operations center (citing 130) contains a multicast server (citing 390) that is able to send documents or files to directories on predefined local servers. The Examiner argues that the Internet protocol using the IP multicast is considered as the multicast communication transport layer since the IP multicast protocols, like the claim feature, is used to send information from one point to many destinations on the network; citing figs. 1 and 3; paragraph [0042]); and

wherein communication is all accomplished via multicast to subscribers by publisher enterprise equipment (citing the system, a response to a unicast request is a multicast response to multiple users. The Examiner argues that if multiple users are associated with a document, then all these users are connected through the multicast communication method; citing [0002] and [0007]-[0009]).

Therefore, the Examiner argues in view of Marks '374, it would have been obvious to one of ordinary skill at the same time the invention was made to have the feature of via multicast communication over a data network and wherein communication is all accomplished via multicast to subscribers by publisher enterprise equipment, incorporated in the device of Murren '085, in order to have a one-to-many transmission protocols used in the transmission of data within the Murren '085 system (citing Marks '374 paragraph [0042]).

However, the references of Murren and Marks fail to teach to wherein a print server facilitates multi-site print load balancing, wherein said print server gauges and determines respective print service sites' print load capacity, expertise requires to print, and shipping and labor costs when facilitating said multi-site print load balancing; managing source page description language (PDL) and storing decomposed PDL files as bitmapped files of said print ready document for consistent print results, management and use of said print-ready document.

However, the Examiner argues that this is well known in the art as evidence by the background of the invention. The Examiner argues that the background of the invention discloses to facilitate multi-site print load balancing, wherein said print server gauges and determines respective print service sites' print load capacity, expertise required to print, and shipping and labor costs when facilitating said multi-site print load balancing (citing the background of the invention uses a print service that makes a decision for information to sites based on the balance of the loads on the sites that are being processed, or multi-site load balancing. The print server also makes the determination of the shipping and labor costs when facilitating the load balancing of print sites before it chooses a location to master a print job. Since the background discloses this feature, the Examiner argues that the claim limitation is performed; citing [0006]-[0009]);

managing source page description language (PDL) and storing decomposed PDL files as bitmapped files of said print ready document for consistent print results, management and use of said print-ready document (citing in paragraph [005], the system contains workstations that are able to communicate information to be printed to a printing device. The Examiner argues that because the background of the invention sends information over a network to the other devices, then the background is viewed as similar to the other applied references above (citing same field of endeavor). Also, the Examiner argues that the background of the invention discloses already print formatted master documents that may be transmitted to a printer directly, which eliminates a need to repeat conversion and decomposition process of another copy if desires. In addition, the master file can be stored at a file service that can manage and store the bitmapped image data along a user obtaining this stored image data for use at a later time; citing paragraphs [0003]-[0009]).

Therefore, in view of the background of the invention, it would have been obvious to one of ordinary skill at the time the invention was made to facilitate multi-site print load balancing, wherein said print server gauges and determines respective print service sites' print load capacity, expertise required to print, and shipping and labor costs when facilitating said multi-site print load balancing and managing source page description language (PDL) and storing decomposed PDL

files as bitmapped files of said print ready document, incorporated in the device of Murren, as modified by the features of Marks, in order to eliminate the need to repeat the conversation or decomposition process if another copy of the document is needed or to save on processing resources of the received data (citing background of the invention paragraph [005]).

Regarding claim 16, the Examiner argues that Murren '085 discloses a system for managing distributed multi-site print ready document libraries comprising:

at least one database (citing the information tracking component contains a database; citing [0017];

at least one document library wherein documents are assigned to predefined topics stored within said at least one database (citing the documents are stored in the system and criteria used to describe the items on the database is predetermined before users are able to receive the subscribed to information; citing [0016]-[0025];

a data network configured to publish availability of said predefined topics to a plurality of print service wherein said print service sites subscribe to at least one of said predefined topics (citing the system of Murren '085, the tracking component (citing 106) publishes the availability of information within a subscribers criteria via a publishing component (citing 110). The Examiner argues that this is not only given to a certain user, but to multiple users requesting the information. When updates occur to information within the user's criteria, multiple users' are notified by the publishing of the information to the users. The Examiner further argues that publishing is interpreted as the dissemination of information to the public. Since the updates and the requesting of information within a user's criteria occurs over a network that notifies multiple user's at the same time, the Examiner argues that the system is considered to perform multicast communication, which is when multiple clients receive the same information from one server. Also, since the sites that are used to receive the data are able to make hard copy flyers that are used to describe the published information, the Examiner further argues that these sites can be considered as print service providers since they provide the service of printing to those located at the specific site; citing fig.1; paragraphs [0006]-

[0025]) utilizing a configuration file conveyed over said data network (citing a lookup table, a value that is input yield a value that is output. Within the Murren reference, the user inputs in a criteria, whether that criteria involves multiple subjects or one subject, and with the input of this criteria, the system maps this criteria to items that correspond with this criteria. In addition, the system maps the user to the information that is requested through the listed criteria.

Therefore, with the user being associated with the subjects requested, the user determines that the above feature is performed; citing fig. 6 [0020]-[0025] and [0048]-[0052]);

at least one server configured to access said predefined topics stored within said at least one database (citing the information tracking and publication system is a server that accesses the different items within the subscribers predefined criteria or topics; citing [0016]-[0022]);

enterprise communication equipment comprising a router and a network access device, wherein a print server is configures to automatically send documents to said plurality of print service sites in accordance with said predefined topics that each of said plurality of print service sites subscribed to (i.e. in the system, the use of the internet and directing certain publications to certain users involves the clear use of a router and a device that accessed a network, such as a WAN or LAN. In the system, when a change has occurred to a document or when a new item has been placed on the database that fits within criteria or a topic that has been input by a user, the system automatically sends the document with the input criteria to the sites of the subscribers. Once the subscribers receive this information, they may be able to print this information out and provide it to other users who are connected with the published information. The Marks reference also disclosed routers in paragraph [0029]; citing [0023] and [0052]-[0054];

publish-subscribe middleware configured to enable said at least one server to operate in conjunction with said at least one database in order to manage subscriber data, topic data and publication-subscription logs (citing the server (citing 102) is used with the tracking component (citing 106), which serves as a database, and these components maintain records of a subscriber (citing 606) and a publication-subscriber log of multiple subscribers (citing 608). The data range is

considered the publication-subscriber log because the information lists the time a subscriber subscribes to a publication on the network. The item identifier is considered as subject data since this information identifies an item that is subscribed to. Also, in figure 5, the input criteria entered by the subscriber can be stored in a dedicated area of the publishing component (citing 110), which is accessed by the server device (citing 102). This information can be considered as subject data. Since the server (citing 102) operates together with the information tracking component (citing 106), which contains a database, that store the above types of information together, the system can be considered to have publish-subscribe middleware; citing figs. 1-6, paragraphs [0047]-[0056]);

at least one rendering device located at each of said print service sites configured to render said documents (citing the system of Murren, a site is able to provide a hard copy of the subscribed to information and provide this hard copy to other concerned with the information. Since this information can be printed with a printing device, the subscribers contain rendering equipment used to output subscription information; citing [0023]).

However, Murren '085 fails to teach network device utilizing a multicast communication transport layer, wherein communication is accomplished via a multicast to subscribers by publisher enterprise equipment.

However, this is well known in the art as evidence by Marks '374. Marks '374 discloses network access device utilizing a multicast communication transport layer (citing the references of Murren and Marks involve the transmission of documents or other information to individuals on a network (citing same field of endeavor). In the system, the network operations center (citing 130) contains a multicast server (citing 390) that is able to send documents or files to directories on predefined local servers. The Internet protocol using IP multicast protocols is considered as the multicast communication transport layer since the IP multicast protocols, like the claim feature, is used to send information from one point to many destinations on the network; citing figs. 1 and 3; paragraph [0042]);

wherein communication is accomplished via a multicast to subscribers by publisher enterprise equipment (citing the system, a response to a unicast request is a multicast response to multiple users. If multiple users are associated with a

document, then all of these users are contacted through the multicast communication method; citing [0002] and [0007]-[0009]).

Therefore, in view of Marks '374, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of network access device utilizing a multicast communication transport layer, wherein communication is accomplished via a multicast to subscribers by publisher enterprise equipment, incorporated in the device of Murren '085, in order to have a one-to-many transmission protocols used in the transmission of data within the Murren '085 system (citing Marks '374 paragraph [0042]).

However, the references of Murren and Marks fail to teach to further wherein a print server facilitates multi-site print load balancing, respective print service sites' print load capacity, expertise required to print, and shipping and labor costs, managing source page description language (PDL) and storing decomposed PDL files as bitmapped files of said print ready documents for consistent print results, management and use of said print-ready document.

However, this is well known in the art as evidence by the background of the invention. The background of the invention discloses to wherein a print server facilitates multi-site print load balancing, respective service sites' print load capacity, expertise required to print, and shipping and labor costs (i.e. the background of the invention uses a print service that makes a decision for information to sites based on the balance of the loads on the sites that are being processed or multi-site load balancing. The print server also makes the determination of the shipping and labor costs when facilitating the load balancing of print sites before it chooses a location to master a print job. Since the background discloses this feature, the claim limitation is performed; citing [0006]-[0009]),

managing source page description language (PDL) and storing decomposed PDL files as bitmapped filed of said print ready document for consistent print results, management and use of said print-ready document (citing paragraph [005], the system contains workstations that are able to communicate information to be printed to a printing device. Since the background of the invention sends information over a network to other devices, then the background is viewed as similar to the other applied references above (same field of endeavor). Also, the

background of the invention discloses already print formatted master documents that may be transmitted to a printer directly, which eliminates a need to repeat conversation and decomposition process of another copy if desired. In addition, the master file can be stored at a file service that can manage and store the bitmapped image data along a user obtaining this stored image data for use at the later time; citing paragraphs [0003]-[0009]).

Therefore, in view of the background of the invention, it would have been obvious to one of ordinary skill at the time the invention was made to have the features of wherein a print server facilitates multi-site print load balancing, respective print service sites' print load capacity, expertise required to print, and shipping and labor costs and managing source page description language (PDL) and storing decomposed PDL files as bitmapped files of said print ready document for consistent print results, management and use of said print-ready document, incorporated in the device of Murren, as modified by the features of Marks, in order to eliminate the need to repeat the conversation or decomposition process if another copy of the document is needed or to save on processing resources of the received data (citing background of the invention paragraph [005]).

The Applicant respectfully disagrees with these assertions and herein amends claims 1 and 16 accordingly to disclose:
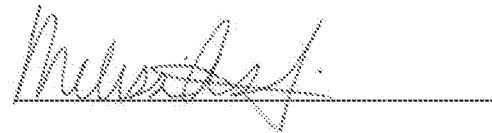
receiving subscriptions for print-ready document library subjects via point-to-point data communication over the data network from remote subscribers at individual sites wherein said subscriptions comprise a configuration file that functions as a lookup table for subjects subscribed to and interested in by said subscribers; receiving document updates automatically, wherein only necessary data related to said predefined topics is synchronized with said remote subscribers located at specific sites...". These limitations are disclosed in Applicant's [013] and [019], respectively. The Applicant respectfully asserts that the prior art fails to teach this combination of amended limitations. The Applicant respectfully requests withdrawal of the rejections and reconsideration of amended claims 1 and 16.

IV. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. Applicant respectfully requests the withdrawal of the objections and rejections based on the preceding remarks and amendments. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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Melissa Asfahani
Attorney for Applicants
Registration No. 59,711
ORTIZ & LOPEZ, PLLC
P.O. Box 4484
Albuquerque, NM 87196-4484
Tel. 915-351-0087
Fax. 505-314-1307